

## **Remarks**

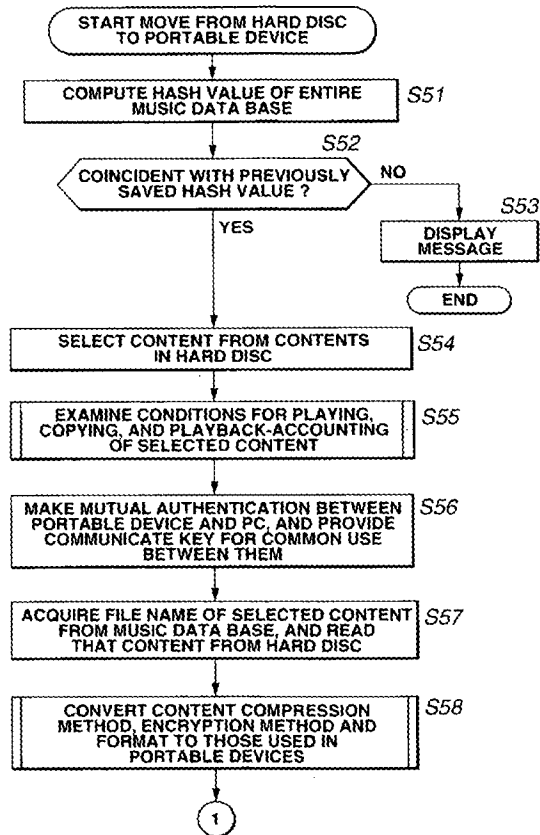
This is responsive to the PTAB's Decision dated October 18, 2012. The amendments are proper in that they do not add new matter, and they are entirely clarifying in nature and tangentially related to patentability.

Independent claims 1 and 9 are amended and new claim 40 is included to more particularly point out and distinctly feature the media file being transferred without any prior consideration as to whether any usage limitation exists for the transferred media file. Support for this feature is found at least in the specification where it discloses the media file being preloaded to the portable data storage module before the access instructions are encoded to the portable data storage module.<sup>1</sup> The skilled artisan readily ascertains that the PTAB's rationale that Kawakami's selected file content can somehow be transferred separate from the file header is untenable for being inconsistent with Kawakami's plain disclosure.

Nonetheless, Applicant has amended the claims without prejudice to remove the issue by more particularly pointing out and distinctly claiming the media file being transferred without any prior consideration as to whether any usage limitation exists for the transferred media file. As Applicant pointed out in appeal, this more explicitly patentably distinguishes the claimed invention over Kawakami which discloses first checking the selected content against usage limitations by the "EXAMINE CONDITIONS FOR PLAYING, COPYING, AND PLAYBACK-ACCOUNTING OF SELECTED CONTENT" step of block S55 of FIG. 12:

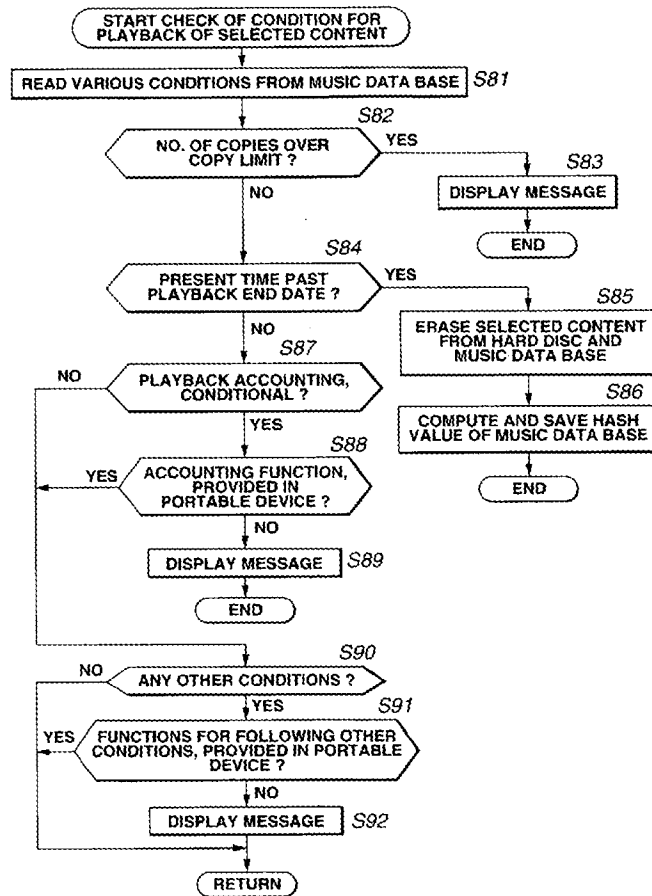
---

<sup>1</sup> See e.g. para. [0022] of the published application 20020095680.



**FIG.12**  
(Kawakami FIG. 12)

Importantly, step S55 is a prerequisite to the steps of moving the selected content to the portable device in Kawakami's FIG. 13. FIG. 15 of Kawakami discloses details of step S55:



**FIG.15**

(Kawakami FIG. 15)

FIG. 15 discloses that if step S55 determines that the number of copies of the selected content is over a limit in step S82, or if there is a time discrepancy in step S84, or if no playback accounting function is available in the portable device in block S88, then the process ends; accordingly, no move of the selected content to the portable device occurs.

The present amendments to independent claims 1 and 9, and new claim 40, more particularly distinguish over Kawakami and the other art of record by transferring the media file without prior consideration as to whether any usage limitation exists for the transferred media file. That is, none of the art of record, individually or combined, teaches or suggests at least the *transferring a media file that is non-encoded with any usage limitation, the transferring occurring without prior*

*consideration of whether any usage limitation exists for the transferred non-encoded media file...*

feature of independent claims 1, 9, and 40. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 9, and 40 and the claims depending therefrom in view of the clarifying amendments.

### **Conclusion**

This is the requisite submission accompanying Applicant's RCE in this case. Applicant respectfully requests passage of all claims to allowance.

Applicant has also submitted herewith a request for telephone interview if, after having reviewed this response, the Office determines that any of the claims is not in condition for allowance. In that case, the presently requested interview is necessary and appropriate to best facilitate progress on the merits by at least addressing any issue that remains unresolved after the Office's consideration of the merits of this response.

The Office is encouraged to contact the undersigned should any question arise concerning this response or anything else concerning this case.

Respectfully submitted,

By: /Mitchell K. McCarthy/  
Mitchell K. McCarthy, Registration No. 38,794  
McCarthy Law Group  
114 East Main Street  
Norman, Oklahoma 73073  
www.mccarthyiplaw.com  
405.310.5188 (office)  
405.227.3677 (cell)  
877.654.6652 (automated msg / email)